Supreme Court, U.S.
FILED
OCT 31 1988
JOSEPH F. SPANIOL, JR.
CLERK

No. 88-728

IN THE

SUPREME COURT OF THE UNITED STATES

TERM 1988 - 1989

JAMES N. CONSTANT,

Petitioner

v.

THE UNITED STATES,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

James Constant
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Pro se petitioner

QUESTION PRESENTED FOR REVIEW

Whether the issuance of a patent by the Patent and Trademark Office creates a contractual relationship between that office and the patentee.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

The petitioner, James Constant, respectfully prays that a writ of certiorari issue to review the judgement of the United States Court of Appeals for the Federal Circuit decided 13 September, 1988 attached as APPENDIX A.

OPINION BELOW

The Court of Appeals for the Federal Circuit issued its decision affirming the judgement of the United States Claims Court attached as APPENDIX B.

JURISDICTION

The jurisdiction of this Court is invoked under 28 USC 1254(1).

STATEMENT OF CASE

On 16 May, 1988, petitioner filed a complaint seeking reimbursal of costs incurred in litigating and defending two of petitioner's patents, which were ultimately declared invalid by the District Court for the Central District of California. The Court of Appeals for the Federal Circuit affirmed the district court judgement. Petitioner has petitioned for a writ of certiorari, and that petition was denied by this Court (NO. 88-308). Petitioner has spent several years litigating and defending the validity of the two patents in the district and appeals courts.

The prior art used to invalidate the two patents was generated by the Government and was or should have been available to the Patent Office before the two patents were issued to the petitioner.

The complaint alleges that the two patents were issued by the Patent Office in breach of the patent grant contract for

(a) unreasonable defects in the two patents caused by the Government;

(b) bad faith and misrepresentation in the inducement of the petitioner to bear the excessive burdens and costs of litigating the validity of the two patents (whether patents are defective or not);

(c) inadvertedly or purposely shifting the excessive burdens and costs of litigating the validity of the two patents from the Patent Office to the petitioner; and

(d) for acquiescence, unclean hands, and inequitable conduct in the knowledge by the Government of (a), (b) and (c) above.

The United States Claims Court dismissed the complaint because "the issuance of a patent does not create a contractual relationship between the Patent Office and the patentee". App. B-3,4. The Court of Appeals for the Federal Circuit affirmed the claims court judgement. App. A-3.

The claim court's jurisdiction for contract claims was invoked under 28 USC 1491.

REASONS FOR GRANTING THE WRIT

1. The Federal Circuit Decision is in Conflict with the Decisions of Many Other Courts of Appeals on the Same Matter

The Government's argument that "A patent is not a contract" is in conflict with the appellate and district court decisions in the 2nd, 3rd, 5th, 7th, 8th and 9th Circuits and indeed in the Federal Circuit's predecessor Court of Claims. Thus,

a. Specifications of patent, including description and claims, constitute a contract between the public and the patentee under which the public, through the government, agrees that, in consideration of the inventor's disclosure of his teaching and his grant of right to use it after his

monopoly expires, he shall be protected in his exclusive use during patent's life. National Carbon Co. v. Western Shade Cloth Co., CCA Ill. 1938, 93 F2d 94, cert. den. 58 S.Ct. 1039, 304 US 570, 82 L.Ed 1535, reh. den. 58 S.Ct 1054, 304 US 590, 82 L. Ed. 1549.

b. A patent is an adjudication and a contract, an adjudication that the device patented was the product of the genius of an inventor, and a contract granting an exclusive right to use and vend the invention for 17 years. Luten v. Kansas City Bridge Co., CCA Mo. 1922, 285 F 840.

c. A patent is a contract. Fried Krupp Aktien-Gesellschaft v. Midvale Steel Co., Pa. 1911, 191 F 588, cert. den. 32 S.Ct. 526, 223 US 728, 56 L.Ed. 633. See also, Railroad Supply Co. v. Hart Steel Co., Ill. 1915, 222 F. 261, 138 CCA 23, motion to

pass denied without prejudice to renew same on proper showing 37 S.Ct. 16, 242 US 609, 61 L.Ed. 525, reversed on other grounds 37 S.Ct. 506, 244 US 294, 61 L. Ed. 1148.

d. A patent is a contract between the government on behalf of the people and the patentee. O.H. Jewell Filter Co. v. Jackson, Mo. 1905, 140 F.340, 72 CCA 304. See also, H.C. White Co. v. Morton E. Converse & Son Co., CCA NY 1927, 20 F2d 311, cert. den. 48 S.Ct. 85, 275 US 547, 72 L.Ed. 419; Tomkins-Hawley-Fuller Co. v. Holden, CCA NY 1921, 273 F. 424; I.T.S. Rubber Co. v. Essex Rubber Co., DC Mass. 1920, 270 F. 593, reversed on other grounds 281 F. 5, appeal dismissed 42 S.Ct. 45, 257 US 664, 66 L.Ed.424.

e. A "patent" is a contract between the public and the inventor, the consideration on the part of the inventor being a complete disclosure in full, clear, concise, and exact language, and the particular claiming of the invention in accordance with statute, and the consideration on the part of the public being the protection of the invention for seventeen years. Daniel v. O&M Mfg. Co., DC Tex. 1952, 105 F.Supp. 336. See also, Davis Airfoils v. U.S., 1954, 124 F.Supp. 350, 129 Ct.Cl. 514, cert. den. 75 S.Ct. 437, 348 US 950, 99 L.Ed2d 742.

f. A "patent" is a contract between inventor and government, supported by consideration, consisting in inventor's disclosure of his invention and government's grant of exclusive monopoly for a stated period of time. U.S. v. Hartford-Empire Co., DC Del. 1947, 73 F.Supp. 979.

g. A patent brings into existence a contractual relationship between the government and the patentee. Owen v. Paramount Productions, DC Cal. 1941, 41 F.Supp.557.

2. The Federal Circuit Decision is in Conflict with A Decision in that Same Circuit

a. "A patent is a contract . . .". Davis Airfoils, supra.

3. The Federal Circuit Decision is Based on Two Decisions in Conflict with Each Other

a. The statement in In re Yardley 493 F2d 1389, 181 USPQ 331 (CCPA 1974) that "A patent is not a contract" while citing the consideration on part of the Government (35 USC 154) fails to give the consideration on the part of the inventor (35 USC 101).

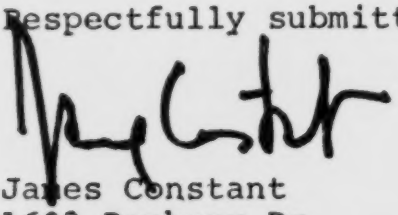
b. The statement in Krantz v. Olin, 356 F2d 1016, 148 USPQ 659 (CCPA 1966) that "We would suggest that this is not a contract case and that an applicant for patent, not withstanding the popular myth that a patent is a contract, is not negotiating with the Government . . . but a process of demonstration and persuasion that the statute has been complied with" while citing the consideration on the part of the inventor (35 USC 101) fails to give the consideration on the part of the Government (35 USC 154).

CONCLUSION

The Federal Circuit decision is inopposite to decisions of many other courts of appeals and its own predecessor court's decision on the same matter. It is based on two decisions in conflict with each other.

For the foregoing reasons, petitioner James Constant respectfully requests that a writ of certiorari issue to review the judgement of the United States Court of Appeals for the Federal Circuit attached as APPENDIX A.

Respectfully submitted



Date: 10/28/88

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A P P E N D I X A

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

88-1426

JAMES CONSTANT,

Plaintiff-Appellant,

v.

THE UNITED STATES,

Defendant, Appellee.

DECIDED: September 13, 1988

Before BISSEL, ARCHER, and MICHEL, Circuit Judges, PER CURIAM.

DECISION

James Constant appeals the judgement of the United States Claims Court, No. 295-88C (May 18, 1988), dismissing his complaint seeking reimbursement of costs incurred in litigating and defending two patents. We have considered the record

and all submissions and, on the basis of the Claims Court order, affirm the trial court's decision.

OPINION

The Claims Court followed the precedents of this court by holding that the issuance of a patent by the United States Patent and Trademark Office (PTO) does not create a contractual relationship between the PTO and the patentee. In re Yardley, 493 F.2d 1389, 1395, 181 USPQ 331, 335-36 (CCPA 1974); Krantz v. Olin, 356 F.2d 1016, 1020, 148 USPQ 659, 662-63 (CCPA 1966), cert. den. 386 US 982 (1967). Constant also advances constitutional challenges to 35 USC 282 (1982 & Supp IV 1986) that we already addressed in Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1563-64, 7 USPQ2d

1057, 1058-59 (Fed. Cir. 1988).

This appeal is frivolous; however, we do not sanction Constant in this instance because this appeal was filed prior to the issuance of Constant. Nonetheless, we reiterate the admonition in that opinion-- "appellant is hereby cautioned that if he persists by trying to raise again the same issues that have been finally decided . . . he could be sanctioned under Fed. R. Civ. P. 11, Fed. R. App. P. 38, and the inherent power of the courts to sanction". Id. at 1572, 7 USPQ2d at 1065-66.

A P P E N D I X B

IN THE UNITED STATES CLAIMS COURT

No. 295-88C
(Filed: May 18, 1988)

JAMES CONSTANT, *

Plaintiff, *

v. *

THE UNITED STATES, *

Defendant. *

* * * * * * * * * * *

ORDER

On May 16, 1988, plaintiff filed a complaint seeking, in substance, reimbursal of costs incurred in litigating and defending two of plaintiff's patents, which were ultimately declared invalid by the District Court for the Central District of California. Plaintiff has appealed the district court judgement,

and that appeal is presently pending with the Court of Appeals for the Federal Circuit (Docket No. 88-1101).

Plaintiff's action must be dismissed for several reasons:

1. It is premature. Plaintiff chose to appeal the district court's judgement; that appeal has not been decided. Therefore, the underlying premise of his complaint -- that the Patent and Trademark Office should not have granted his patents -- is not established.

2. While this court has jurisdiction over contract claims pursuant to 28 USC 1491, no contract exists here. The court rules as a matter of law that the issuance of a patent by the Patent and Trademark Office does not create a contractual

relationship between that office and the patentee. */

3. Plaintiff's arguments that 35 USC (2),(3) (1982) is unconstitutional are, with one possible exception, beyond this court's jurisdiction. To the extent that plaintiff argues that the enforcement of that provision constitutes a taking in violation of the fifth amendment, the court rejects that argument. Assertion of a defense of patent invalidity by a defendant in an infringement action does not constitute a taking by the Government.

4. The balance of plaintiff's arguments sound in tort, see Smithson v. United States, No. 87-1459 (Fed. Cir.

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*/ If plaintiff is claiming that a contractual relationship is implied in law, not fact, the claim would be beyond the court's jurisdiction.

May 11, 1985), and are beyond the court's jurisdiction.

The Clerk is directed to dismiss the complaint.

ERIC G. BRUGGINK
Judge

CERTIFICATE OF SERVICE

I certify that the foregoing PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT was served by mailing the required number of copies first class on 10/28/88 addressed as follows:

Solicitor General
United States Department
of Justice
Washington, D.C. 20530

Date: 10/28/88

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